

REMARKS

Claims 1, 2, 8-10 and 21-40 remain pending in the application. These claims are all rejected under 35 U.S.C. § 103 based on combinations of prior art, as follows:

A. **Claims 1 and 2** are rejected over the combination of:

- i) Sloo (U.S. Pat. No. 5,895,450);
- ii) eShare (www.eshare.com, retrieved from Internet Archive Wayback Machine); and
- iii) Herz (U.S. Pat. No. 6,029,195),

B. **Claims 8-10, 21-22 and 30-31** are rejected over the combination of:

- i) Sloo (U.S. Pat. No. 5,895,450); and
- ii) Siefert (U.S. Pat. No. 5,904,845),

C. **Claims 23, 25-29, 32 and 34-36** are rejected over the combination of:

- i) Sloo (U.S. Pat. No. 5,895,450);
- ii) Eisen (Are We Ready For Mediation in Cyberspace, BYU Law Review, v1998n4, pp. 1305-1358); and
- iii) Herz (U.S. Pat. No. 6,029,195),

D. **Claim 24** is separately rejected over the combination of:

- i) Sloo (U.S. Pat. No. 5,895,450);
- ii) Eisen (Are We Ready For Mediation in Cyberspace, BYU Law Review, v1998n4, pp. 1305-1358); and

- iii) Herz (U.S. Pat. No. 6,029,195), and

E. **Claims 37-40** are rejected over the combination of:

- i) Sloo (U.S. Pat. No. 5,895,450);
- ii) Eisen (Are We Ready For Mediation in Cyberspace, BYU Law Review, v1998n4, pp. 1305-1358); and
- iii) eShare (www.eshare.com, retrieved from Internet Archive Wayback Machine).

Applicant respectfully traverses these rejections, for the reasons set forth below.

1. Rejection of Claims 1 and 2

The Official Action rejected claims 1 and 2 under 35 U.S.C. § 103(a) as being obvious over Sloo in view of eShare, and further in view of Herz. This rejection is respectfully traversed.

Claim 1 recites:

1. A method of resolving a dispute, comprising:
 - at least one of a plurality of parties to the dispute providing, via an on-line connection, an input relating to the dispute;
 - information related to resolution of the dispute being provided, via the on-line connection, to at least one of the parties; and
 - providing at least a portion of the input in a publicly accessible on-line form and allowing at least some people who access the on-line form to interact therewith,
 - wherein the step of allowing interaction includes allowing a question of a party in the dispute, and
 - wherein the publicly accessible on-line form includes a dispute related advertising field including an advertisement that is selected by a computer based system.

The Office Action relies upon Sloo to teach the first three steps (i.e., the “at least one” step, the “information” step and the “providing” step). The Office

Action recognizes that Sloo fails to teach or suggest the limitations in the first wherein clause (i.e., the “question of a party” limitation), but suggests that eShare can be relied upon for this limitation. The Office Action also recognizes that both Sloo and eShare fail to teach or suggest the limitations in the second wherein clause (i.e., the “dispute related advertising field” limitation), but suggests that Herz can be relied upon for this limitation.

A. Sloo

Sloo is a U.S. Patent entitled “Method and Apparatus for Handling Complaints”. It describes an automated process for handling, processing and resolving complaints. Column 1, Lines 13-15. Sloo describes an improvement over conventional systems, such as complaining directly to a vendor (column 1, lines 17-19), or the lodging of a complaint with the Better Business Bureau (column 1, line 27), by suggesting a mechanism for receiving anonymous complaints (column 1, line 57) and using an automated system to resolve the dispute (column 1, line 63 – column 2, line 3). Sloo suggests that “once the disputes are resolved, their settlements . . . are stored . . . in the data records,” and the public will have access to these post-dispute records (column 2, lines 3-12).

Sloo describes an asynchronous system, such as an email-based system driven by a central computer connected to a “conventional” telecommunications network (column 3, lines 7-39). As Sloo describes his invention in terms of what was conventional at the time (or at least what Sloo knew to be conventional), Sloo does not teach or suggest how, if at all, his invention could be employed in a web-based system.

B. eShare

The eShare reference “allows users to perform a wide-range of real-time community tasks . . . through any standard web browser.” Page 1 of 1. As noted in the Office Action, included among these are “adding chat, threaded discussion forums and online presentations to web sites.” Also, the “user-friendly interface works with any browser.” Id.

C. Herz

Herz is a U.S. patent entitled "System for Customized Electronic Identification of Desirable Objects." It describes a search mechanism intended "to generate a user-customized rank ordered listing of target objects most likely to be of interest to each user so that the user can select from among these potentially relevant target objects, which were automatically selected by this system from the plethora of target objects that are profiled on the electronic media" (abstract). As noted in the Office Action, Herz mentions that "advertisements which are relevant nature of the content being discussed at present may provide temporary links to the appropriate product such that when the nature of the content changes the advertisements changes (may disappear) accordingly." Column 7, lines 47-51.

D. Discussion

The rejection of claim 1 rests on the logical premise that one of ordinary skill in the art of the present invention, prior to reading the presently pending application, would look at these three disparate references, and obviously conjure up the claimed invention. This makes no sense. Further, this is an improper piecemeal analysis applied to a multiple element claim, whereby the Office Action merely tries to find individual elements in respective references, and then suggest these elements should somehow be combined, with no showing of how one of skill in the art, at the time of the invention, would have been motivated to do so, without engaging in improper hindsight reconstruction.

Initially, one must recognize the asynchronous, email-based nature of Sloo, and recognize that it does not teach a website, or any other form of web-based system, but instead teaches a central computer accessed via a conventional telecommunications network. The Office Action ignores this deficiency, and simply concludes that it would have been obvious to add an eShare-like chat function to Sloo's asynchronous system. The Office Action does not point to anything in Sloo to provide the motivation to make such a combination. In fact, there is no such suggestion in Sloo. Why would one add a

chat function to an asynchronous, email-based system? How would it work? There are no answers to these questions because the combination is nonsensical.

Further, the Office Action jumps to an improper conclusion that such a combination somehow yields (in an obvious manner) the presently claimed invention (or at least the first four elements thereof). Instead, when Sloo suggests that certain records be "publicly accessible", these suggestions refer to after-the-fact access to records of previously resolved complaints. There is no suggestion in Sloo that there be any "public access" and "interaction" with respect to an on-going complaint resolution process.

Thus, even were one to conjure up a speculative combination of Sloo and eShare, it would be nothing more than allowing a chat about the results of a previously resolved complaint. There is absolutely no basis to suggest that such a combination would yield the claim limitation "wherein the step of allowing interaction includes allowing a question of a party in the dispute."

Still further, the suggestion that one could simply combine a conventional chat function into a complaint system to yield the presently claimed invention is incorrect. As the attached declaration of Professor Clif Kussmaul states, when the first prototypes of askthejury.com were in development by the Moravian University computer science department, the task was not easily accomplished, and there were no off-the-shelf modules that could simply be plugged together. Instead, the computer science team put forth effort to create a web-based dispute resolution system, and to provide for real-time interaction between the parties to the dispute, while also enabling real-time interaction between a third party (e.g., a member of the public) and one of the parties to the dispute.

Thus, when the Office Action states, based simply on the mere existence of Sloo and eShare, that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the step of allowing interaction includes allowing a question of a party in the dispute, as disclosed by eShare, in the system disclosed by Sloo," this is not true. Further, the rationale for why it would have been obvious is nothing more than hindsight

reconstruction. The Office Action recognizes the novel advantages of the present invention, because they are clearly set forth in the presently pending application, and, based on these teachings, concludes that some of these novel advantages are the exact reasons why one of ordinary skill in the art would obviously combine these unrelated references to yield the presently claimed invention.

In particular, the Office Action states that the motivation for this combination is "for the advantage of providing a method of interactively settling disputes with the ability to increase the marketability of the system by creating an entertaining medium by soliciting opinions and interactive inputs from additional system users." The motivation does not come from Sloo. The motivation does not come from eShare. The motivation comes from the teachings of the present application. Prior to the present application, nobody even recognized that there could be an advantageous method of interactively settling disputes. Prior to the present application, nobody even recognized that a dispute resolution process should even be concerned with marketability. Prior to the present application, nobody even considered making an on-line dispute resolution system an entertaining medium. Prior to the present application, nobody recognized that a path to such an entertaining medium could include the solicitation of opinions and interactive inputs from additional system users. In fact, even today, more than five years after the priority date of the present application, there is still no recognition of these advantages, as there are no existing websites that combine these features.

The Office Action continues down this path of hindsight reconstruction by conjuring up a basis for adding Herz to the mix, and concluding that the resulting combination makes the claimed invention obvious. In particular, the last limitation of claim 1 states that "the publicly-accessible on-line form includes a dispute related advertising field including an advertisement that is selected by a computer based system." The Office Action posits that Herz "teaches real time profiling of user dialogs in a text chat session, in order to provide advertisements, which are relevant to the nature of the content being discussed." However, as noted above, Sloo is not a real-time system, and there is thus no basis to add a

chat function. Also, as discussed above, absent the teachings of the present application, there is no suggestion to focus on marketability, and hence no basis to even consider offering advertisements. Applicant is not suggesting that the present invention is the first to include content-based advertising. However, Applicant is the first to suggest real-time, entertaining, dispute resolution where the use of such content-based advertising makes sense.

As in the earlier combination, the Office Action lifts the motivation from the presently pending application, where it states that it would have been obvious to make such a combination "for the advantage of providing a method of interactively settling disputes with the ability to create additional sources of income by providing user customized (target profiling) advertising." There is no basis for this suggested advantage, other than the improper use of hindsight resulting from an understanding of the present application.

Based on the foregoing, Applicant respectfully submits that claim 1 is in condition for allowance, and requests that the presently pending rejection be reconsidered and withdrawn.

E. Claim 2

Claim 2 depends from claim 1, and is therefore patentable for all of the reasons provided above. Further, claim 2 recites:

2. A method as recited in claim 1, further comprising the step of at least one of the parties providing payment information for use in obtaining a fee associated with the service of providing the resolution related information.

The Office Action states, in a general fashion, that "Sloo, eShare, and Herz disclose at least one of the parties providing payment information for use in obtaining a fee associated with the service of providing the resolution related information." Applicant respectfully solicits a proper rejection, whereby the Office identifies (i) the particular portion of the particular reference that is being relied upon to show this claim element, and (ii) if the reference is not the primary reference, the motivation for combining this portion of the secondary reference with the primary reference.

2. Rejection of Claims 8-10, 21-22 and 30-31

The Office Action rejects claims 8-10, 21-22 and 30-31 as obvious over the combination of Sloo and Siefert (U.S. Pat. No. 5,904,485). Of the claims in this group, claim 9 is independent, and claim 10 depends therefrom. There is a procedural problem, however, with respect to the rejection of the remaining claims (8, 21-22 and 30-31), as they all depend from claim 23, and claim 23 is not part of this group. Applicant, therefore, respectfully submits that the rejections of these claims (8, 21-22 and 30-31) are not properly formulated. If the Office corrects this problem in response to this amendment, and puts forth a procedurally proper rejection of these claims, Applicant respectfully submits that such a rejection will by necessity be in the form of new grounds of rejection, must afford Applicant the opportunity to respond, and thus can not be set forth in the form of a Final Rejection. As the only properly formulated rejection is to claims 9 and 10, Applicant will respond to these rejections below.

Based on the forgoing, Applicant respectfully submits that claim 2 is in condition for allowance, and requests that the presently pending rejection be reconsidered and withdrawn.

A. Claim 9

Claim 9 recites:

9. A method of resolving a dispute, comprising:
 - at least one of a plurality of parties to the dispute providing, via an on-line connection, an input relating to the dispute;
 - information related to resolution of the dispute being provided, via the on-line connection, to at least one of the parties;
 - providing at least a portion of the input in a publicly accessible on-line form and allowing at least some people who access the on-line form to interact therewith; and
 - determining which people that access the on-line form are permitted to interact therewith

based on an assessment of at least one of the person's knowledge of the law and the person's knowledge of the facts,

wherein the determining step includes assessing the person's knowledge by providing the person a set of one or more questions and evaluating the person's responses to the questions, and

wherein the person is provided another set of questions from the larger set of questions if the person does not answer a predetermined number of the questions correctly.

For this rejection, the Office Action relies on the same primary reference as in the earlier discussed rejections (Sloo), and suggests an obvious combination with Siefert (U.S. Pat. No. 5,904,485).

B. Siefert

The Siefert reference is entitled "Automated Lesson Selection and Examination In Computer-Assisted Education." It is directed to computer-based learning in order to "allow students to attend school, yet remain at home" or "provide formal education at geographic distributed sites." Column 1, line 67 – column 2, line 2.

C. Discussion

Applicant respectfully traverses this rejection.

As an initial matter, Applicant notes the earlier discussion with respect to the asynchronous, email-based nature of Sloo, and notes that the arguments put forth in the context of claims 1 and 2 are equally applicable to claim 9. Further, the Office Action posits that the claimed interaction with the on-line form, which is permitted based on an assessment of one of the person's knowledge of the law and knowledge of the facts is somehow taught or suggested by Siefert, and this teaching is obviously combinable with Sloo. Applicant disagrees.

Although the Office Action points to many sections of Siefert, none of these sections discuss "knowledge of the law" or "knowledge of the facts." Applicant requests that if this rejection is maintained, any subsequent

communication specifically point to which particular section of a reference is being relied upon to teach or suggest each element of the claimed invention. Instead, in the present rejection, the Office Action (i) recognizes that Sloo does not include a particular aspect of the claimed invention (paragraph 14, "Sloo fails . . . the person's knowledge of the law and the person's knowledge of the facts"), (ii) proffers that Siefert suggests something different (paragraph 15, "Siefert further teaches assessing the knowledge level of a user"), (iii) points to many parts of Siefert ("Abstract, C7 L18-25, C9 L58-60, C15 L51-67, C16 L1-19, C19 L32-35, C20 L1-15, Fig2-3.") without showing which part relates to the actual claim language, and (iv) erroneously concludes that the general act of assessing a person's knowledge meets the claim limitations. This is not correct, and Applicant respectfully requests that rejections be directed to the actual claim language, not a convenient paraphrasing thereof. Applicant respectfully asserts that any such attempt will be a failure, in this case, as the reference makes no mention of assessing a person's knowledge of the law or a person's knowledge of the facts.

Further, the claim includes the limitations directed to assessing by providing a set of questions and evaluating the response, and providing another set of questions if the person does not answer a predetermined number of questions correctly. Again, it is not clear which portion of the reference is being relied upon for these limitations. For example, the Office Action points to column 15, lines 51-67. This section describes a "diagnostic check" to be performed if a student scores below average. The diagnostic check is not another set of questions, but is, instead, an opportunity for the system to receive feedback from the user. After the diagnostic check, the student is presented a menu screen with the following three choices: "further study"; "change subjects"; and "log off" (column 16, lines 7-9). Thus, Applicant respectfully submits that the present rejection is inadequate in that it does not specify how, if at all, the reference meets this limitation of the claim for two reasons: the claimed second set of questions from the larger set; and the assessment (i.e., the questions) being related to the law or the facts.

Still further, the proposed combination is simply piecemeal hindsight reconstruction. There is no logical reason to combine these references, and there is nothing in the references that suggests such a thing. Why would one look to combine a reference related to an asynchronous email-based complaint handling system with a reference related to remote education? Even taken from the perspective of today, there is no reason to conclude that there would be any reason to combine such references. Clearly, when viewed at the time of the invention, without the benefit of hindsight associated with the teachings of the present application, such a combination is comical. If driven to do so, one can conjure up possible combinations. For example, the school system employing the invention of Siefert could employ a complaint handling mechanism as described in Sloo. However, the function of the patent office is not to take piecemeal references and then, with the benefit of hindsight, be driven to conjure up such a combination. Instead, the mission is to put oneself in the position of one of ordinary skill in the art at the time of the invention, and make a determination as to whether such an artisan, having the benefit of these disparate references, would recognize that it is obvious to combine them in a way that teaches the presently claimed invention. This rejection does not come close to meeting this standard.

The Office Action points to a particular portion of Sloo, perhaps in an attempt to show some suggestion for the combination. In particular, the Office Action points to column 8, lines 5-18, and states that "Sloo does teach pre-qualifying the judge and jurors" (paragraph 15). However, what Sloo actually states in the cited section is the following:

If the user selected "Request a Judge/Jury" option in step 700, the program proceeds to step 712 which provides initial instructions to allow either the complainant or subject to request intervention by a third party to resolve the dispute. The program then selects a judge or jury in step 714 from a list of pre-qualified persons who may have agreed to serve as judges or jurors. Preferably, these pre-qualified persons are categorized by criteria that is helpful in selecting an appropriate judge or jury so that the program can compare the characteristics of the person on the judge/jury list to the characteristics of the dispute to select a judge or jury that would be the most appropriate

for the dispute. For example, judges and jurors who have technical skills may be identified and selected to resolve disputes involving technical matters.

In contrast to the assertion made in the Office Action, this cited portion of Sloo is completely silent about the process of "pre-qualifying". Thus, it is not true to state that "Sloo does teach pre-qualifying the judge and jurors." Instead, what this portion of Sloo teaches is that there is a list of pre-qualified persons, and this list should preferably be categorized, so that, for example, someone with technical skills is selected if the dispute involves technical matters. Most likely, pre-qualification is accomplished via a conventional process, such as based on technical degree. Thus, electrical engineers would be in one category, computer scientists in another, psychiatrists in another, and medical doctors in yet another.

Since Sloo does not, in fact, teach "pre-qualifying," there is absolutely no basis to suggest that one of ordinary skill in the art, at the time of the invention (i.e., without the benefit of hindsight) would even consider taking the teachings of Sloo (categorizing pre-qualified people) and combining them with Siefert's description of performing a diagnostic check to somehow conjure up the presently claimed invention. And, the standard is not whether some particular idiosyncratic person of skill in the art might somehow come up with an obscure off-the-wall combination. The standard is that such a combination would be obvious to one of ordinary skill in the art. This standard is simply not met in the present case. Further, even were one to somehow decide to follow the lead of the particular idiosyncratic person, there is no basis to argue that the resulting combination would obviously be exactly what happens to be claimed in the presently pending claim. In fact, Sloo teaches away from the proposed combination because Sloo describes the persons as being pre-qualified. If they are already pre-qualified, why would one even consider asking them a set of questions?

The basis offered in the Office Action for this combination is completely based on hindsight, as the Office Action states that one would do this "for the advantage of providing a method of interactively settling disputes with the help of people who have knowledge to settle the dispute, the knowledge determined through a pre-qualifying set of questions." Applicant notes that the Official Action

introduces a feature of the recited claim, the "interact" feature, as part of its statement of the motivation to combine the references. However, the cited art does not disclose the "interact" feature, and the Official Action does not point to where this is found. Instead, the Official Action uses its motivation to combine to provide missing elements of the claim.

Further, Applicant appreciates the indication, once again, that Applicant's invention provides advantages. However, the claimed combination and its advantages were first proposed by Applicant in the presently pending application, and this teaching can not be used against Applicant to supplement the way one of ordinary skill in the art actually would have reacted to the disparate pieces of prior art.

Based on the foregoing, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

D. Claim 10

Claim 10 depends from claim 9, and is therefore patentable for all of the reasons stated above. Further, claim 10 recites an additional step of providing educational information to the person prior to providing another set of questions. As discussed in the context of claim 9, if one is already pre-qualified (as described in Sloo), why would one even consider asking a first set of questions, not to mention providing educational information and a second set of questions? This makes no sense.

Based on the foregoing, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

3. Rejection of Claims 23, 25-29, 32 and 34-36

The Office Action rejects claims 23, 25-29, 32 and 34-36 as obvious over the combination of Sloo, Eisen and Herz. Sloo and Herz have been discussed above. As far as this rejection is concerned, Eisen is the new reference (i.e., the one that is not discussed above). Claim 23 is the only independent claim in this

group. All of the other claims depend, either directly or indirectly, from claim 23. Claims 23 recites:

23. A method of resolving a dispute, comprising:
at least one of a plurality of parties to the dispute providing, via an on-line connection, an input relating to the dispute; and
interaction directed towards resolving the dispute occurring in substantially real-time between at least one of the parties to the dispute and another person, wherein the substantial real-time interaction is displayed on at least a display and the display includes a dispute related advertising field including an advertisement that is selected by a computer based system.

As can be seen from the claim, the first limitation is the same as that for the previously discussed independent claims. The second limitation, however, includes additional limitations directed to substantially real-time interaction and dispute related advertising.

The piecemeal approach of the Office Action is continued in this rejection, as Sloo is relied upon to teach the first limitation, Eisen is relied upon to teach the second limitation, Herz is relied upon to teach the third limitation, there is no effort to show how any of the references suggest combining them, and the rejection concludes by saying one of ordinary skill in the art would somehow magically recognize an obvious combination of three disparate references based on the hindsight benefit of the advantages taught by the Applicant.

A. Eisen

Eisen is directed towards a mediation system which is inherently private and confidential, as Eisen does not teach or suggest anything other than conventional mediation. As such, the provider of such services necessarily takes steps to insure the privacy and comfort of the participants, and goes out of its way to insure that the participants do not have even the perception that the forum is somehow anything other than private. The Office Action ignores this aspect of the proffered reference (which is 45 pages in length), and instead focuses on one particular footnote, which states:

40. See, e.g., Granat, *supra* note 1 (noting that in the On-Line Mediation Service, "E-mail will be used by the mediator to communicate with each of the parties"). The On-Line Mediation Service also supports "Internet Relay Chat" technology, which enables users to communicate textually in real time. See *id.* This communication, being textual, has many of the same drawbacks for mediation as E-mail. See *infra* Part II. Technology such as the "Instant Message" capability available on the America Online service is similarly limited.

The Office Action refers to "IRC Technology", which presumably refers to the "Internet Relay Chat" segment of the footnote.

B. Claim 23

As mentioned earlier, the Office Action seems to be of the view that simply "adding chat" to an asynchronous, email-based, non-public system will somehow yield the presently claimed invention, and that such a combination would have been obvious to one of ordinary skill in the art at the time of the invention without said one of skill in the art having read the present application. As also discussed earlier, and made clear in the attached declaration, the invention is not simply the addition of "chat" to a previously existing system. When the Office Action points to footnote 40 of Eisen, and says "Eisen teaches wherein on-line mediation services are conducted through the use of IRC technology – which enables users to communicate in real time", the Office Action fails to show, because it can not, how this teaches the claimed invention.

Mediation is a form of Alternative Dispute Resolution (ADR). Mediation necessarily involves a mediator, and the job of the mediator is to communicate, in private, with each of the parties to a dispute, and to suggest possible resolutions to the dispute. The footnote cited by the Office Action is limited. It mentions "Internet Relay Chat" and that this enables "users to communicate textually in real time," but does not provide sufficient detail regarding what this means. From the perspective of today, and with the benefit of examining the present application, one might jump to the conclusion that this suggests the claimed "interaction directed toward resolving the dispute occurring in substantially real time between one of the parties to the dispute and another person," but the reference does not actually teach that. Just before the sentence

referring to "Internet Relay Chat," the footnote says that "E-mail will be used by the mediator to communicate with each of the parties". In the "Internet Relay Chat" sentence, however, the footnote says that this technology "enables users to communicate in real time." Who are these users? What are they communicating about? The reference is so scant, one can only speculate. Applicant respectfully submits that it is not proper to guess that the users must include "at least one of the parties" or that the communication is "interaction directed toward resolving the dispute." Also, it is not clear what is included in "Internet Relay Chat." How does this function? What are its capabilities and limitations? Without answers to these issues, one can only speculate regarding whether the footnote has any relevance to the presently claimed invention.

Further, the Office Action fails to address why one of skill in the art would even think of taking Sloo's e-mail based complaint handling system, and combining it with anything suggested in a mediation related reference. Sloo provides many suggestions regarding how the invention described therein will improve society by acting as a judge (column 8, line 6, etc.), an automatic decision maker (column 9, line 57, etc.), an enactor of laws (column 15, line 47, etc.) and even an enforcer (column 16, line 32), but does not suggest mediation in any form. If not for the quest of trying to find some way to shoehorn any reference to "real time" in to the rejection, it is unclear why one would even think of taking an obscure footnote within a mediation article and combine it with the teachings of Sloo.

Still further, as discussed previously, there is no basis for the suggestion that one would even think of adding targeted advertisements of Herz to either Sloo or Eisen. The piecemeal approach of the Office Action simply states that "Therefore, it would have been obvious . . ." But the real question is "Why?" Why would it have been obvious to take a private activity, such as the private filing of a complaint with a company, or a private mediation, and insert advertising? Imagine sitting at a private session with a marriage counselor, and all of a sudden a divorce lawyer walks into the room. Your first reaction would likely be shock, and you might then wonder how the lawyer knew you were there and what you were discussing. You clearly would question the confidentiality of

the proceedings. Thus, by their very nature, both Sloo and Eisen, which teach confidential proceedings, teach away from the concept of adding advertising, as the addition of targeted advertisements would necessarily imply a lack of privacy, or at least a perception thereof, because the ads would be targeted towards private information provided in supposedly private or confidential settings. Thus, one skilled in the art, based on the teachings therein, would not find any motivation to combine Herz with Sloo or Eisen because Sloo and Eisen specifically teach away from such a combination.

The Office Action states that this combination would have been obvious to one of ordinary skill in the art, at the time of the invention, "for the advantage of providing a method of interactively settling disputes with the ability to create additional sources of income by providing user customized (target profiling) advertising." This makes no sense. As Sloo is not real time, but is an email based system driven from a central computer, it is not targeted to revenue generation. The only reference to money in Sloo is the suggestion to collect user fees in order, for example, to pay judges, jurors and witnesses as a reward for their participation. Similarly, Eisen is directed to private, confidential mediation. There is no plausible way to think that parties to a private mediation as described by Eisen would even think of raising revenue, let alone to do so by opening their mediation to the public and charging advertisers. Of course, after the benefit of the present application, one realizes the brilliance of the present invention, perhaps says "why didn't I think of that?" and recognizes the possibilities. But, the point in time to do this analysis is the time of the invention, not the present, and, therefore, the proposed combination does not work.

Based on the foregoing, Applicant respectfully requests that the rejection of claim 23 be reconsidered and withdrawn.

C. Claim 25

Claim 25 recites:

25. A method as recited in claim 23, wherein the other person is a third party other than (a) one of the parties to the dispute or (b) a judge.

The totality of the analysis in the Office Action with respect to this claim is contained in paragraph 29, where it states that “[a]s per Claim 25, Sloo, Eisen and Herz disclose wherein the other person is a third person other than one of the parties to the dispute”. Applicant respectfully suggests that it would be very helpful if any future Office Actions point to particular parts of particular references that are relied on to teach each limitation.

As claim 25 depends from claim 23, it is patentable for all of the reasons stated above with respect to claim 23. Further, Applicant respectfully submits that the Office has not met its burden to show that the prior art teaches or suggests interaction directed towards resolving the dispute occurs in substantially real-time between at least one of the parties to the dispute and a third party, where the third party is someone other than one of the parties to the dispute and a judge, and wherein the substantial real-time interaction is displayed and the display includes a dispute related advertising field including an advertisement that is selected by a computer based system.

Based on the foregoing, Applicant respectfully requests that the rejection of claim 25 be reconsidered and withdrawn.

D. Claim 26

Claim 26 recites:

26. A method as recited in claim 25, further comprising the step of enabling another third party to view the dispute without enabling the other third party to interact with the parties.

The totality of the analysis in the Office Action with respect to this claim is contained in paragraph 30, where it states that “[a]s per Claim 26, Sloo, Eisen and Herz disclose enabling another third party to view the dispute without

enabling the other third party to interact with the parties". As before, Applicant respectfully suggests that it would be very helpful if any future Office Actions point to particular parts of particular references that are relied on to teach each limitation. In this case, as in the others, the Office Action simply parrots back the claim language, and essentially passes the burden to Applicant to figure which reference contains the claim limitation and to conjure up how the Office is reading the reference. Applicant respectfully submits that this is not proper, and the burden should not be shifted to Applicant until after the Office has met its burden.

As claim 26 depends from claim 25, which depends from claim 23, this claim is patentable for all of the reasons provided above with respect to those claims.

Further, as discussed above with regard to the rejection of claims 1 and 23, Sloo does not disclose interaction towards resolving a dispute occurring in substantially real-time where the substantial real-time interaction is displayed on at least a display. Further, Sloo does not disclose enabling another third party to view the dispute that includes interaction occurring in substantially real-time where the substantial real-time interaction is displayed on at least a display without enabling the other third party to interact with the parties. The Official Action cited Eisen for teaching real-time interaction. However, the Official Action did not site Eisen for teaching enabling another third party to view the dispute that includes interaction occurring in substantially real-time where the substantial real-time interaction is displayed on at least a display without enabling the other third party to interact with the parties. Further, Eisen does not disclose this step. Also, Applicant does not see any basis for the suggestion that this step is somehow shown in the Herz targeted advertising reference. Thus, the Official Action failed to cite any art, alone or in combination, that discloses the claimed step, and claim 26 is further distinguished from the cited art.

Based on the forgoing, Applicant respectfully request the rejection of claim 26 be reconsidered and withdrawn.

E. Claim 27

Claim 27 depends from claim 23 and is also patentable for the reasons stated above. This claim states:

27. A method as recited in claim 23, wherein the interaction comprises a question directed to the at least one of the parties.

The totality of the analysis in the Office Action with respect to this claim is contained in paragraph 31, where it states that “[a]s per Claim 27, Sloo, Eisen and Herz disclose wherein the interaction comprises a question to the at least one of the parties”. As before, the Office Action simply parrots back the claim language, and passes the burden to Applicant to figure which reference contains the claim limitation and to conjure up how the Office is reading the reference. Applicant respectfully submits that this is not proper, and the burden should not be shifted to Applicant until after the Office has met its burden.

The claim states that the interaction comprises a question directed to the at least one of the parties. As the interaction is recited in claim 23 as “interaction directed towards resolving the dispute occurring in substantially real time between at least one of the parties to the dispute and another person”, the Office Action is summarily asserting, without any particular pointers or references, that this interaction, in the form of a question directed to the at least one of the parties, is disclosed in Sloo, Eisen and Herz. Applicant respectfully requests the Office specifically state where this is disclosed by identifying the particular reference and the particular text within the reference. Applicant can not find it.

Based on the foregoing, Applicant respectfully requests that the rejection of claim 27 be reconsidered and withdrawn.

F. Claim 28

Claim 28 also depends directly from claim 23, and is therefore also patentable for the reason stated above. This claim states:

28. (Previously Added) A method as recited in claim 23, wherein the interaction comprises a vote on which party should prevail.

As with the previous dependent claims, the amount of detail provided by the Office is limited. The totality of the analysis in the Office Action with respect to this claim is contained in paragraph 32, where it states that "[a]s per Claim 28, Sloo, Eisen and Herz disclose wherein the interaction comprises a vote on which party should prevail." Which specific reference shows this? Which part of the reference is being relied upon? These are questions to which Applicant can only guess. Presumably, it is not Herz, as it is hard to imagine how voting on a prevailing party is at all related to target advertising. But, Applicant can not be sure as the Office Action appears to be intentionally vague. Presumably, it is not Eisen, as it is hard to imagine how voting on a prevailing party has anything to do with private mediation. But again, the vagueness of the Office Action is problematic. This leaves only Sloo, which is directed to the e-mail based system. How does Sloo teach "interaction directed toward resolving the dispute occurring is substantially real time wherein the interaction comprises a vote on which party should prevail"? Applicant respectfully requests learned guidance from the Office.

Based on the foregoing, Applicant respectfully requests that the rejection of claim 28 be reconsidered and withdrawn.

G. Claim 29

Claim 29 is also dependent from claim 23, and is therefore patentable for the reasons stated above. This claim states:

29. A method as recited in claim 23, wherein the input is in written form.

In this case, the analysis is similar as for the other dependent claims, in that the Office Action contains, in paragraph 33, a single line stating that "Sloo, Eisen, and Herz disclose wherein the input is in written form." Unlike the aforementioned dependent claims, where Applicant believes the Office has not met its burden to show where in the references the claimed element is shown, in this case Applicant agrees that the references do include teachings of written input. However, the written input taught by the references is not interaction

directed towards resolving the dispute occurring in substantially real time between at least one of the parties to the dispute and another person.

Based on the foregoing, Applicant respectfully requests that the rejection of claim 29 be reconsidered and withdrawn.

H. Claims 32 and 34-35

These claims also depend directly from claim 23, and are therefore patentable for the reasons provided above. As with the earlier claims, the Office Action provides a summary one sentence paragraph, without pointing to particular portions of particular references to show how each of these limitations is met.

I. Claim 36

Claim 36 is also dependent on claim 23, and is patentable for all of the reasons provided above. This claim recites:

36. A method as recited in claim 23, wherein the dispute related advertising field includes an advertisement related to a fact of the dispute.

With regard to this claim, the Office Action states in paragraph 37 that "Sloo, Eisen and Herz disclose "wherein the dispute related advertising field includes an advertisement related to a fact of the dispute." Unlike in all of the above cases, however, the Office does make an effort to point to a particular portion of a particular reference, and Applicant appreciates the effort. Specifically, the Office Action points to "(Herz: C7 L44-51, C67 L47-54)."

The specified portion of column 7 states:

Text chat (or acoustic voice chat) using a text to speech conversion module may be used in conjunction with real time profiling of the real time user dialogues occurring within the chat session. Advertisements which are relevant nature of the content being discussed at present may provide temporary links to the appropriate product such that when the nature of the content changes the advertisements changes (may disappear) accordingly.

The specified portion of column 67 states:

In a fourth application, the system scans the transcripts of all real time spoken, written or acoustic (e.g., audio or video streaming data) on the network that are currently in progress, and employs news clipping technology to rapidly identify content which is most appropriate for a particular advertisement or promotion that may pertain to the target object profile of the content presently occurring.

Neither one of these sections says anything about a dispute related advertising field including an advertisement related to a fact of the dispute. At best, they suggest that one can provide promotional links relating, in general, to content being discussed. This says nothing about a fact of the dispute. As discussed earlier, the combination of Herz with Eisen and Sloo is problematic because of their respective confidential and non real time nature. However, even were one to conjure up the idea of somehow incorporating target advertising into one or the other of these references, there is no basis for the conclusion that such advertising would be related to a fact of the dispute. There may be many bases for developing target advertising, and the idea of incorporating advertising into a dispute resolution system was not suggested anywhere prior to the present application. But, even were one, without the benefit of hindsight, to somehow think of doing this (which is a far cry from it being obvious to the ordinary artisan), there is no basis for the suggestion that the thinker would go the next step and determine that the target advertising could be related to a fact of the dispute. This is clearly not taught or suggested by the references in any way.

Based on the foregoing, Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Based on the foregoing, Applicant respectfully requests that the rejection of claim 36 be reconsidered and withdrawn.

4. Rejection of Claim 24

Claim 24 also depends from claim 23, and is also rejected as obvious over the exact same references discussed above: Sloo, Eisen and Herz. Claim 24 is therefore patentable for all of the reasons stated above with respect to claim 23. This claim recites:

24. A method as recited in claim 23, wherein the other person is a juror.

In this case, unlike with respect to all of the other deficiencies discussed above, the Office Action recognizes that "Sloo, Eisen and Herz fail to expressly show wherein the other party is a juror." However, the Office Action decides that in this case it doesn't matter that the applied art does not teach or suggest the limitation. Instead, the Office Action states:

40. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The dispute resolution system would be performed regardless of the parties involved in the dispute. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

41. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have resolved a dispute for a multiple array of parties, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

The cases cited by the Office are perplexing. In *Gulack*, the claims were to an article, not a method as recited in the present application. Further, the Federal Circuit reversed the Board of Patent Appeals and Interferences, and found patentability by deciding that the printed matter on the substrate served a functional purpose. The Federal Circuit implies that if there is printed matter on an article and the matter has nothing to do with the functioning of the article, then it would be appropriate to deny patentability of the article claim based exclusively on the printed matter. This has no relation to the presently pending method claims, where, as described in the specification, particular embodiments of the claimed invention rely upon the presence of a juror (or jurors) and the interaction between a party (or parties) to the dispute and the juror.

In fact, the *Gulack* case provides excellent guidance for the Office in examining claims, such as those pending in the present case. The Court states:

Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole. If the board meant to disregard that basic principle of claim interpretation, we must reverse the rejection as a matter of law.

217 U.S.P.Q. 403, 404 (emphasis added). Applicant respectfully submits that much of the proceedings associated with this application are precisely counter to

the principle set forth in this case cited by the Office. Instead of considering the claim as a whole, the Office elects to practice an improper piecemeal approach, and completely ignores parts of a claim when they are inconvenient to the Office's mission, which appears to be to continuously deny the proper issuance of a patent regardless of the facts. Applicant suggests that this application be reconsidered in light of the law clearly set forth in the case that the Office cited.

In *Lowry*, the Court also provided excellent guidance that is most helpful to the issuance of the presently pending claims. Here, the invention was directed to a data processing structure. Again, the Federal Circuit overruled the rejection of the Board. The Federal Circuit pointed out that

the printed matter cases have no relevance where the "invention as defined in the claims requires that the information be processed not by the mind but by a machine, the computer."

32 U.S.P.Q.2d 1034. Clearly, the presently pending claims all include an on-line attribute, and the guidance from the Court makes it clear that this rejection cannot stand.

Based on the forgoing, Applicant respectfully requests that the rejection of claim 24 be reconsidered and withdrawn.

5. Rejection of Claims 37-40

Claims 37-40 stand rejected as obvious over Sloo (asynchronous e-mail based complaint system) in view of Eisen (mediation) and further in view of eShare (chat). Claims 37 and 40 are independent. Claims 38 and 39 depend from claim 37.

A. Claim 37

Claim 37 states:

37. A method of resolving a dispute, comprising:

(a) at least one of a plurality of parties to the dispute providing, via an on-line connection, an input relating to the dispute;

(b) interaction, directed towards resolving the dispute occurring in substantially real-time, involving at least one of the parties to the dispute; and

(c) interaction, occurring in substantially real-time, between a third party and at least one of the plurality of parties to the dispute, wherein the third party is not one of (a) the plurality of parties to the dispute, (b) a judge, and (c) a juror.

The Office Action follows a similar piecemeal approach. It recognizes that Sloo doesn't say anything about real time. It refers to the footnote in Eisen to conclude that this is an adequate teaching of real time, and contorts a reason to combine these disparate references, despite the fact that they won't work together and there is no suggestion to do so, by relying on the advantages taught in the present application. The Office Action then recognizes that this contorted combination fails to teach or suggest the (c) element of the claim. For this limitation, the Office Action relies on the chat function of eShare, implying that the simple existence of chat functionality which could be added to a web page (which both Sloo and Eisen are not) somehow makes obvious the entirety of element (c), and would make such a combination obvious to one of skill in the art at the time of the invention without the benefit of hindsight from the present application. Again, the motivation for this latter combination is straight from the application, and is not present anywhere in the prior art. In reality, this combination is ludicrous, the references don't come close to teaching or suggesting the claim, and the Office should follow the advice of the Federal Circuit and stop playing games.

Based on the foregoing, Applicant respectfully request the rejection of claim 37 be reconsidered and withdrawn.

B. Claims 38 and 39

These claims depend from claim 37, and are therefore patentable for the reasons provided above. Further, claim 38 recites that steps (b) and (c) occur at substantially the same time. The Office Action states that this is "inherent to chat technology". If such is the case, Applicant respectfully requests the Office provide a reference that is prior to the filing date of the priority document, and which teaches or suggests that real-time interaction involving a party to a dispute that is directed towards resolving the dispute inherently occurs at the same time as real time interaction between a third party (non-party, non-judge and non-

juror) and a party to the dispute. This is not inherent to anything except the teachings of the present application.

Claim 39 recites that the interaction is displayed on a display. As noted in the Office Action, it is known to display things on a display. However, as noted above, there is no teaching or suggestion in the art to display the specific interaction recited in claim 37 on a display.

Based on the foregoing, Applicant respectfully requests that the rejections of claims 38 and 39 be reconsidered and withdrawn.

C. Claim 40

Claim 40 is independent, and recites:

40. A system for fostering the resolution of a dispute, comprising:

a computer adapted to receive from at least one of a plurality of parties to the dispute, via an on-line connection, an input relating to the dispute;

the computer further adapted to receive an interaction directed towards resolving the dispute in substantially real-time between at least one of the parties to the dispute; and

the computer further adapted to arrange the input and the interaction for display in substantially real-time as the interaction towards resolving the dispute occurs, on a display of a person who is not one of (a) the plurality of parties to the dispute, (b) a judge, and (c) a juror.

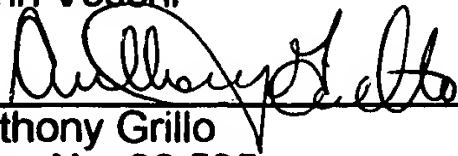
Claim 40, which is directed to a computer-based system, is patentable for reasons similar to claim 37. The Office Action relies on Sloo, improperly combines it with Eisen to show "real-time", and improperly combines this combination with the chat function of eShare by relying on the advantages described in the present application. As stated earlier, this is wrong, and the Office should reconsider its position.

Based on the foregoing, Applicant respectfully requests that the rejection of claim 40 be reconsidered and withdrawn.

Conclusion

Based on the forgoing, the above-identified application is in condition for allowance.

Respectfully Submitted,
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Dated: November 17, 2004

Attached: Clean Copy of Claims
Declaration